

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* Roger Hoffman¹
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11 Appeal 2007-3413
12 Application 09/516,648
13 Technology Center 1700
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16 Decided: August 21, 2007
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19 *Before:* FRED E. MCKELVEY, *Senior Administrative Patent Judge,*
20 SALLY GARDNER LANE and SALLY C. MEDLEY, *Administrative*
21 *Patent Judges.*

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23 LANE, *Administrative Patent Judge.*
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26 DECISION ON APPEAL
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28 STATEMENT OF CASE
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30 Applicant appeals under 35 U.S.C. § 134(a) (2006) from a final
31 rejection of claims 1, 3-5, 7, 8, 10-20, 22, and 23². We have jurisdiction

¹ The real party in interest is said to be The Hoffman Group, Ltd. (Br. 1).

² The Examiner has maintained the rejection of claims 9 and 21 (Answer at 3 and 7) but according to the listing of claims filed on 18 March 2004 and the Appeal Brief, these claims have been cancelled.

under 35 U.S.C. § 6(b) (2006). In this Decision we refer to the Applicant Roger Hoffman as “Hoffman”.

The invention is said to relate “to paper laminates and a method for preparing paper laminates, and more particularly to paper laminates used for disposable cups, disposable plates, book covers, folding cartons and beverage containers.” (Specification at 1).

The following US Patents were relied upon by the Examiner in rejecting the claims on appeal:

<u>Inventor</u>	<u>Pat. No.</u>	<u>Issue Date</u>
Confer	US 3,603,501	7 Sept. 1971
Holder, Jr.	US 3,982,056	21 Sept. 1976
Peer, Jr.	US 4,525,173	3 Mar. 1981
Cavagna	US 4,898,752	6 Feb. 1990
Knudsen	US 4,913,773	3 Apr. 1990

The Examiner has maintained the following grounds of rejection:

Claims 1-5, 7, 8, 10, 12 -14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cavagna in view of Peer, Jr. (Peer). (Answer at 4-6.)

Claim 11 is rejected under 35 U.S.C. § 103(a) over the combination of Cavagna and Peer and further in view of Holder, Jr. (Holder). (Answer at 5-6).

Claims 15 and 17-19 are rejected under 35 U.S.C. § 103(a) over the combination of Cavagna and Peer and further in view of Confer. (Answer at 7).

Claims 15-19 and 21-23 are rejected under 35 U.S.C. § 103(a) over the combination of Cavagna and Peer and further in view of Knudsen. (Answer at 7-8).

ISSUE

Whether the claimed subject matter would have been obvious in view of (1) Cavagna and Peer or (2) Cavagna and Peer in view of Confer, Hoffman, or Knudsen.

FINDINGS OF FACT

1. According to the Hoffman Specification it was known to make paper packaging having an inner paper base that is then coated with a separate paper layer that can be printed with graphics, i.e., a label. (Specification at 2).

2. According to Hoffman, a problem with these known paper laminates is said to be that the laminates allow the unbleached paper, which is dark in nature, to “show through.” (Specification at 2-3).

3. Further, according to the Hoffman Specification, the problem has been solved in the art by using bleached paperboard instead of unbleached paper. (Specification at 2-3).

4. However, the bleached paperboard is said to be “more costly to produce and lacks the strength of unbleached paperboard.” (Specification at 2).

5. The problem also is said to have been solved by using a white pigmented adhesive to adhere the label to the unbleached paper. (Specification at 3).

6. According to Hoffman, objects of the claimed invention are to provide a replacement for bleached paperboard and to make it

unnecessary to add a pigment to the adhesive layer used to attach the label to the paper base. (Specification at 3).

7. Claim 1, set out below, is illustrative of the claimed subject matter:

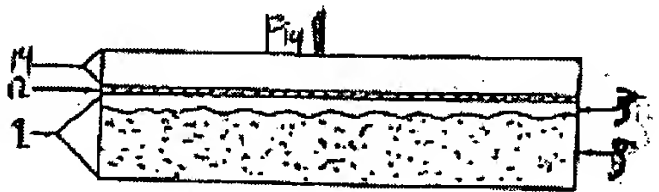
A laminate composite sheet comprising:
a two-ply base layer comprised of a bottom ply and a top ply, wherein the bottom ply is comprised of unbleached cellulosic fibers and wherein the top ply is comprised of bleached or brightened cellulosic fibers;

a further layer attached to the top ply with a layer of adhesive; said further layer having a top and a bottom surface, said further layer selected from the group consisting of paper or film; said layer of adhesive containing no pigment, and said top surface of said further layer having no coating.

8. According to the Hoffman Specification, “[a] ply refers to a layer of cellulosic fiber which is bonded to at least one other layer of cellulosic fiber at the wet-end of the paper machine.” (Specification at 3).

9. The plies are said to be “pressed together in the press section of the papermachine and are subsequently dried together, thus forming a single web of paper or board.” (Specification at 3).

10. Figure 1 below is useful to show the structure of the laminate sheet:



11. Shown in the above figure is a two-ply structure 1 having a top ply of bleached or brightened cellulosic fibers 3 and a bottom ply

1 of unbleached cellulosic fibers 5, an adhesive layer 12 and a layer of
2 paper or film 14 (i.e., label).

3 Cavagna

4 12. The Examiner relies upon a portion of the Cavagna
5 Specification entitled "BACKGROUND OF THE INVENTION",
6 which states:

7 Outer packaging material is generally understood in the
8 industry to comprise wrappers, carriers and the like for primary
9 containers such as bottles or cans. Most outer packaging material is
10 made of paper, or paperboard, typically referred to as folding carton
11 material or corrugated paperboard. Unbleached paperboard is
12 specifically manufactured to be used for outer container packaging.
13 High strength is desired, so the board is usually produced from strong
14 fiber and contains chemical additives to resist moisture. After the
15 board is made, it had been the custom in the industry to finish at least
16 one surface with a white coating or the like, to permit printing of the
17 naturally brown, rough surface of the unbleached board.....[A]n
18 outer thin layer of high-quality label paper or a plastic film have [sic-
19 has] been laminated to one surface of the unbleached paper-board to
20 provide a printable surface.

21
22 (Cavagna at 1:10-29)

23 13. Cavagna essentially repeats what the Hoffman Specification
24 says is conventional in the art of outer paper packaging, i.e., to use
25 unbleached paperboard and then cover it with a printable label.

26 14. Peer teaches a paper packaging material to be used in, e.g.,
27 six pack bottle carriers.

28 15. Peer teaches a carrier having improved strength and
29 appearance at a lower cost made by laminating an inner paper material
30 such as unbleached kraft paper or recycled board (or for labels, high

1 grade bleached craft paper), with a transparent plastic film material
2 that may be decorative (Peer at 1:53-65, 5:10-50 and 7:14-21).

3 16. An adhesive is used to attach the film to the inner paper
4 material. (Peer at 3:64-65).

5 17. The adhesive may be an adhesive that does not contain a
6 pigment (Peer at 4:6-9; the adhesive “may” contain pigment and
7 other additives “if desired.”)
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9 PRINCIPLES OF LAW

10 We read the claims in view of the Specification. A limitation may not
11 be read into a claim from the Specification, but it is appropriate to look to
12 the Specification to define a limitation already in the claim. *Elekta Instr.*
13 *S.A. v. O.U.R. Sci. Int'l, Inc.*, 214 F.3d 1302, 54 USPQ2d 1910, 1913 (Fed.
14 Cir. 2000).

15 The factual inquiry into whether claimed subject matter would have
16 been obvious includes a determination of: (1) the scope and content of the
17 prior art; (2) the differences between the claimed subject matter and the prior
18 art; (3) the level of ordinary skill in the art; and (4) secondary consideration
19 (e.g., the problem solved) that may be indicia of (non)obviousness. *Graham*
20 *v. John Deere Co. of Kansas City*, 383 U.S.1, 17-18 (1966). There must be
21 some “articulated reasoning with some rational underpinning to support a
22 legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78
23 USPQ2d 1329, 1336 (Fed. Cir. 2006).

24 ANALYSIS

25 Claims 1-5, 7, 8, 10, 12 -14 are rejected under 35 U.S.C. § 103(a) as
26 being unpatentable over Cavagna et al. (Cavagna) in view of Peer, Jr. (Peer).

(Answer at 4-6.) Each of the other claims on appeal, i.e., claim 11, 15-20, 22, and 23, is rejected over a combination of Cavagna and Peer in view of a third reference as set out above.

Cavagna and the Hoffman Specification acknowledge that it was known in the art to make packaging material of unbleached paper and then to attach a layer of paper label or plastic film atop of the unbleached paper to allow for a printable surface.

Cavagna does not teach a two-ply base layer as defined by Hoffman in the Specification. To the extent the Examiner has found that Cavagna teaches a two ply base layer because it discusses adding a label to a layer of unbleached paper, we do not agree. The Hoffman Specification defines each ply of the two ply layer as being “a layer of cellulosic fiber which is bonded to at least one other layer of cellulosic fiber at the wet-end of the paper machine” such that the two plies are “dried together, thus forming a single web of paper or board.” The two ply structure is illustrated at reference numbers 3 and 5 of Hoffman figure 1. We understand the unbleached layer of Cavagna to be equivalent to reference number 1 of figure 1 of Hoffman and the paper label of Cavagna to be equivalent to reference number 14 of Cavagna. Cavagna does not discuss an embodiment where the layer 1 has two different plies as claimed by Hoffman.

The Examiner does not rely upon Peer for a teaching of, nor have we been able to find where Peer teaches, an inner paper layer having two plies. Peer teaches a plastic film that may be decorative, i.e., a label, that has, as one advantage, the ability to add strength to the unbleached or recycled inner paper of the packaging.

The Examiner has not articulated a sufficient reason why one skilled in the art would have modified either Cavagna or Peer in such a way that the claimed two ply base paper would result. In any event, the top layer of the Cavagna packaging is a label. It is not clear to us why one skilled in the art would have had added to the Cavagna packaging an additional label such as that taught by Peer.

We REVERSE the rejection of claims 1-5, 7, 8, 10, 12 -14 .

The additional references relied upon, i.e., Holder, Jr., Confer, and Knudson, are not relied upon by the Examiner as teaching a two-ply base paper or for providing a reason why one skilled in the art would have added the label of Peer to an already labelled packaging material. Thus, these references do not make up for the deficiencies of Cavagna and Peer.

The rejection of each of the other claims on appeal is reversed for the same reason that the rejection of claims 1-5, 7, 8, 10, 12 -14 is reversed.

CONCLUSIONS OF LAW

The rejection of claims 1, 3-5, 7, 8, 10-20, 22 and 23 under 35 U.S.C. § 103(a) is REVERSED.

REVERSED

Philip M. Weiss
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